

REMARKS

Claims 1-4, 6-9, 12, 13, 15-17, 21, and 22 are amended, claims 18 and 19 are cancelled, and new claims 23-26 are added. The specification is also amended. Applicants have amended the pending independent claims 1 and 16 in order to define more particularly the subject matter sought to be patented, without prejudice to pursue the original subject matter, for example, in a continuation application. No new matter has been added.

Accordingly, claims 1-9, 11-17, and 20-26 are currently pending in the application. Applicants respectfully request favorable consideration of the present application in light of the amendments to the claims and the following remarks.

Specification

Through this amendment, Applicants have amended the specification with the addition of two paragraphs. The material added to the specification through this amendment was incorporated by reference at the time of filing via the incorporation by reference of PCT App. Serial No. PCT/US02/22247, entitled “System and Methods for Determining Nerve Proximity, Direction, and Pathology During Surgery,” filed July 11, 2002; PCT App. Ser. No. PCT/US02/30617, entitled “System and Methods for Performing Surgical Procedures,” filed September 25, 2002; and PCT App. Ser. No. PCT/US03/02056, entitled “Systems and Methods for Determining Nerve Direction to an Instrument,” filed on January 15, 2003. As such, no new matter has been entered through this amendment.

New Claims

Applicants note that new dependent claims 23-26 are supported by the paragraphs inserted into the specification through this amendment. This subject matter was properly incorporated by reference at the time of filing and as such does not constitute new matter.

Claim Rejections - 35USC 103(a)

Claims 1-9, 11-15, and 23-24

Independent claim 1 and particular dependents were rejected under 35 USC 103(a) as being unpatentable over US Patent 5,728,046 to Mayer et al. (“Mayer”) in view of US Patent 6,206,826 to Mathews et al. (“Mathews”). Applicants respectfully submit that even if there was

a reason that would have prompted a skilled artisan to modify the Mayer reference as proposed (an issue that is not conceded herein), the proposed combination of Mayer and Mathews would nevertheless fail to disclose all the elements of independent claim 1.

Unlike claim 16, Mayer fails at least to teach a primary retractor having a “plurality of retractor blades **abutting each other in a closed position** and forming a closed perimeter,” as described in claim 1. Mathews also fails to teach a retractor system wherein the primary retractor assembly has a plurality of retractor blades abutting each other in a closed position and forming a closed perimeter, and thus cannot fill the voids left by Mayer.

Applicants respectfully submit that independent claim 1 is patentable over Mayer, Mathews, and all other references cited in the record. Dependent claims Applicants respectfully submit that independent claim 1 is patentable over Mayer, Mathews, and all other references cited in the record. Dependent claims 2-9, 11-15, and 23-24 are patentable at least for the same reasons as independent claim 1 and the additional features described therein. Prompt allowance of claims 1-9, 11-15, and 23-25 is respectfully requested.

Claims 16, 17, 20-22, and 25-26

Independent claim 16 and particular dependents were rejected under 35 USC 103(a) as being unpatentable over Mayer in view of Mathews. Applicants respectfully submit that even if there was a reason that would have prompted a skilled artisan to modify the Mayer reference as proposed (an issue that is not conceded herein), the proposed combination of Mayer and Mathews, would nevertheless fail to disclose all the steps described in the method of claim 16.

Unlike independent claim 16, Mayer fails at least to teach a primary retractor with a closed position characterized by a “plurality of retractor blades being positioned to abut one another and form a closed perimeter.” Moreover, Mayer also fails to teach the step of “coupling an additional retractor blade to said retractor assembly **after** said plurality of retractor blades have been moved to said open position.” According to the Office Action, the holders 20/21 and retractor body 32 (both of which are components of support feet 39, 40) of Mayer are considered supplemental retractor assemblies (a characterization the Applicants do not necessarily agree with and do not concede herein). Nevertheless, in examining Mayer, it is clear that the support feet are not inserted after the other retractor blades, but instead, are inserted either before or simultaneously with the other blades. To insert the retractor of Mayer, bone screws 36 and accompanying extensions 35 are first screwed into adjacent vertebral bodies. Thereafter the

retractor is lowered onto the screw extensions by sliding the support feet 39, 40 (over the screw extensions 35. *Mayer, Col. 3 ln. 42-53*. Alternatively, the support feet 39, 40 may be inserted onto the screw extensions 35 first, and thereafter the rest of the retractor can be attached to the support feet 39, 40. *Mayer, Col. 3 ln. 58-62*. Like Mayer, Mathews also fails to teach each of a primary retractor with a closed position characterized by a “plurality of retractor blades being positioned to abut one another and form a closed perimeter,” and the step of “coupling an additional retractor blade to said retractor assembly **after** said plurality of retractor blades have been moved to said open position,” and cannot fill the voids left by Mayer.

Applicants respectfully submit that independent claim 16 is patentable over Mayer, Mathews, and all other references cited in the record. Dependent claims 17, 20-22, and 25-26 are patentable at least for the same reasons as independent claim 16 and the additional features described therein. Prompt allowance of claims 16, 17, 20-22, and 25-26 is respectfully requested.

Conclusion

It is believed that all of the pending claims have been addressed. However, the absence of a reply to a specific rejection, issue or comment does not signify agreement with or concession of that rejection, issue or comment. In addition, because the arguments made above may not be exhaustive, there may be reasons for patentability of any or all pending claims (or other claims) that have not been expressed. Finally, nothing in this paper should be construed as an intent to concede any issue with regard to any claim, except as specifically stated in this paper, and the amendment of any claim does not necessarily signify concession of unpatentability of the claim prior to its amendment. Applicants specifically reserve the right to pursue the subject matter of independent claims 1 and 16 (prior to amendment herein) in a continuing application.

The foregoing amendments have been submitted to place the present application in condition for allowance. Favorable consideration and allowance of the claims in this application is respectfully requested. Applicants hereby authorizes a payment of the \$555.00 fee for the 3 month Extension of Time Request, and a \$52.00 fee for the addition of 2 excess claims to be charged to Deposit Account No.: 50-2040 for Customer No.: 30,328. No other fees are believed to be due at this time, however, in the event that there are any additional fees to be charged or payments to be credited, the Applicants hereby request that any charges or credits be made to Deposit Account No.: 50-2040 for Customer No.: 30,328. In the event that there are any

questions concerning this Amendment or the application in general, the Examiner is cordially invited to telephone the undersigned attorney so that prosecution may be expedited.

Respectfully submitted,
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